



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#32

Applicants: Bruce Eisen et al.
Assignee: User Trends, Inc.
Title: Electronically Distributing Promotional And Advertising Material Based Upon Consumer Internet Usage
Serial No.: 09/379,167 Filing Date: 08/23/99
Examiner: John L. Young Group Art Unit: 3622
Docket No.: M-7729 US

APPEAL BRIEF

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Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

INTRODUCTION

Pursuant to 35 U.S.C. 134, "an applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal."

This is an Appeal from the Examiner's fifth rejection of all claims. The last rejection was issued on April 23, 2003 (Paper #27). The Notice of Appeal was mailed on July 15, 2003 and received on July 21, 2003 in the U.S. Patent and Trademark Office.

I. REAL PARTY IN INTEREST

The real party in interest is UserTrends, Inc. 1801 Avenue of the Stars, Suite 929, Los Angeles, CA 90067.

II. RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences.

III. STATUS OF CLAIMS

Claims 1-52 and 75-82 are currently pending in the Application. This Appeal is directed to the rejection of claims 1-52 and 75-82, a copy of which appears in the Appendix attached to this Appeal Brief.

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IV. STATUS OF AMENDMENTS

No Amendment has been filed in response to the last rejection of the Examiner dated April 23, 2003.

V. SUMMARY OF THE INVENTION

Referring to pages 14-18 of the Specification, and Figures 6A-7B, the present invention relates to a method for electronically identifying a consumer without requiring consumer registration. The method comprises embedding a unique identifier within a web site address. The unique identifier uniquely identifies an email recipient. The web site address is then included in an email message and the email is sent to the email recipient.

The web site address included in the email is in form of a reference (i.e., hyperlink) that can be selected by a user. Clicking on the hyperlink provides the email recipient with access to one or more web sites, by for example opening a web page in a browser. An example of a hyperlink is shown in Figs. 6B, 6C namely <http://www.mystore.com/?XXXX> (Figs. 6B, 6C are attached as **Exhibit 1**). The portion of the hyperlink reference identified as "XXXX" constitutes a unique identifier.

In response to the selection of the reference, a client computer connects to a server computer and submits a request to the server to access website content. The request includes the website address (e.g., "http://www.mystore.com/") and by default the unique identifier (e.g., "XXXX"), since the unique identifier is "embedded" in the request (e.g., <http://www.mystore.com/?XXXX>) forwarded to the server. See Fig. 6B.

Once the request is received by the server computer, the request is recorded in the server's web log file or files. Referring to Fig. 7A, the unique identifier is illustrated as element 703 ("UTID=XXXX") as recorded in the server's web log, in association with other logged details (e.g., elements 701, 702) for that user (Fig. 7A is attached as **Exhibit 2**). The request can be parsed to retrieve the unique identifier embedded therein. Thus, the email recipient can be identified based on the retrieved unique identifier and his/her movement within the website can be tracked by tracing the unique identifier in association with other information recorded in the web log.

The logged details provide information about the particular locations (i.e., web sites) visited by a user, the IP address of the client computer, the duration of time the user visited each location, and other useful information about the user's web surfing activities. Since, each record in the web log can be, either directly or indirectly, traced to a unique identifier for a particular user, all details associated with each user can be easily collected. For example, the details of the web log can be analyzed to build user profiles.

Advantageously, the tracking method of the present invention is performed without requiring active registration of the individual, or reliance on any intrusive profiling mechanisms (e.g., cookies) that require

read/write access to the "client computer" or substantial communications and operational overhead.¹ That is, all tracking information can be directly and conveniently extracted from the server's web log, rather than from the client computer or another server acting as an intermediary between the client computer and the server.

The particular privacy sensitive features and technological advantages of the tracking method of the present invention in contrast to the inconvenient and intruding features of prior art consumer profiling systems are fully disclosed in Declaration of Bruce Eisen, CEO of UserTrends, Inc., and Declaration of James Fedolfi, VP of eContacts, Inc., attached herewith as **Exhibit 3**. Said under oath executed declarations were forwarded to the Examiner on or about November 15, 2002 (prior to the first Examiner Interview), and more recently to the Supervising Examiner, on or about June 24, 2003 (prior to the second Examiner Interview) to establish evidence of secondary considerations, as objective evidence of non-obviousness, pursuant to MPEP Section 716. The board is hereby requested to review and consider the attached declarations as such.

VI. ISSUES

(1) Whether the Examiner's repeated rejection of claims based on "common knowledge" in absence of any supportive evidence as required under MPEP Sections 2144.03 and 2143 is proper, particularly when such supportive evidence has been seasonably requested by the Applicant, "for each instance of rejection," and the Examiner has failed to provide any evidence, whatsoever.

(2) Whether the systems and methods defined in claims 1-52 and 75-82 are obvious in light of the teachings of Capiel, United States Patent No. 6,449,634 (hereinafter "Capiel").

VII. GROUPING OF CLAIMS

Claims 1-52 and 75-82 should be grouped as provided below.

Group 1: Claims 1, 22, 45, 52, 75, 78, and 81.

Group 2: Claims 2, 10, 23, 46, 76, 79, and 82.

Group 3: Claims 3, 4, 24, 25, 47, 48, and 51.

Group 4: Claims 5, 26, and 50.

Group 5: Claims 6-14, 27-35, and 80.

Group 6: Claims 15-21, 36-44, 49 and 77.

The claims do not stand or fall together, regardless of grouping, for reasons set forth in the Argument. A brief summary of the elements claimed in each group is provided below.

¹ See Declaration of Bruce Eisen, and Declaration of James Fedolfi, attached herewith as Exhibit 3.

Group 1: Independent method and system claims 1, 22, 45, 52, 75, 78, and 81 recite the elements of the present invention including steps and means for embedding a unique identifier within a web site address, the unique identifier uniquely identifying an email recipient; including the web site address in an electronic mail message sent to the email recipient, wherein the web site address provides the email recipient with access to one or more web sites; establishing a connection between a client computer used by the email recipient to receive the email and a server computer providing access to the one or more web sites, in response to the email recipient selecting a reference to the web site address included in the electronic mail message; providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request, to retrieve the unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier; and tracking the email recipient's movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.

Group 2: Dependent claims 2, 10, 23, 46, 76, 79, and 82 recite preferred features of the method and system of the invention for storing the unique identifier, in at least one log file, in association with the information that defines consumer activity; and extracting the information that defines consumer activity based on said association to track consumer movement.

Group 3: Dependent claims 3, 4, 24, 25, 47, 48, and 51 recite a preferred feature of the method and system of the invention wherein the act of associating the unique identifier with information that defines consumer activity comprises identifying connection specific information related to the established connection between the client computer and the one or more web sites, wherein the connection specific information is automatically logged in correspondence with the information that defines consumer activity; and associating the unique identifier with of the connection specific information such that information that defines consumer activity can be extracted based on the association between of the connection specific information and the unique identifier. The claimed connection specific information, in certain preferred embodiments, is the IP address² of the client computer, or the operating system³ executing on the client computer.

Group 4: Dependent claims 5, 26, and 50 recite a preferred embodiment of the invention in which the unique identifier is the email address of a consumer.

² See claims 3, 24, and 48.

³ See Claim 51.

Group 5: Dependent claims 6-14, 27-35, and 80 recite various preferred features of the method and system of the invention reciting website content accessibility and web log content providing information about consumer behavior during a visit to the website, such as web pages visited and duration of visit.

Group 6: Dependent claims 15-21, 36-44, 49 and 77 recite various preferred features of the method and system of the invention further comprising developing a consumer master database based upon the web log file; querying the master database; and determining consumer preferences. The master database, in certain embodiments is constructed to comprise various segments including consumer related information such as email, promotional material, purchases, URLs associated with key codes and keywords, and credit card data.

ARGUMENT

The claims in this appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,449,634 ("Capiel"). For clarity, we refer to the prosecution history of this matter briefly. A review of the prosecution records indicates that the claims in the present application have been rejected five times, each time based on prior art searches that have produced a variety of references, none of which is pertinent to the subject matter of the invention.

As such, the prosecution of this matter has been unnecessarily lengthened as the result of the Patent Office inability to perform adequate searches to identify pertinent prior art. There has been also a reluctance in performing searches and setting an interview environment that is conducive to discussing more analogous art. Particularly, the Examiner has failed to make any effort to provide any suggestions that would lead to identifying patentable limitations that can be drafted into the claims in order to put the case in condition for allowance,⁴ despite numerous requests by the Applicants.

It is noteworthy that each Office Action includes numerous admissions by the Examiner that Capiel lacks explicit recitation of all the elements in the claims.⁵ The Examiner, however, has repeatedly alleged that "the concept and advantages of said undisclosed elements were well known in the art," without providing any support for these allegations. The record shows that the Examiner, in violation of provisions of MPEP §2144.03,⁶ has failed to provide such support, even when requested by the Applicants.

The above shortcomings constitute the premise for this appeal. To wit, the record of the

⁴ See last paragraph of "Attachment to Interview Summary of Paper No. 28," signed by Supervisory Patent Examiner Eric W. Stamber, dated June 23, 2003, attached as Exhibit 4.

⁵ See Office Action dated April 23, 2003, pages 4-19, 22-31, and every basis of rejection in Office Action dated November 27, 2002.

⁶ See Applicant's response to Office Action mailed November 27, 2002, page 8.

Applicants' last interview with the Patent Office, memorialized by Supervisory Examiner Eric W. Stamber, attests to the impropriety of the repeated rejections and Applicants' frustration of the same.⁷ In fact, the record of the aforementioned interview, attached as **Exhibit 4**, so succinctly summarizes the issues before the board and the distinction between the invention and the cited prior art, that we highly recommend the board to review the interview summary prior to proceeding with considering the points discussed in this brief.

Accordingly, the Applicants respectfully traverse the grounds of rejection for the following reasons, each of which are discussed in further detail below.

(i) In absence of a cited reference for a claimed limitation, rejection based on "common knowledge" is not persuasive without a supportive affidavit.⁸

(ii) The cited reference is non-analogous prior art with respect to the claimed subject matter of the present invention, and therefore is an improper reference.

(iii) The present invention as claimed is patentably distinct from the cited reference because there is no motivation to modify the reference to perform the claimed process and system of the present invention.

The former two arguments are related to all claims and are discussed preliminary. The latter argument is discussed in more detail with respect to related claims.

(A) Rejection based on "common knowledge" is not persuasive without further support.

Since Capiel by itself "lacks explicit recitation of all the elements of the claimed invention,"⁹ the Examiner contends that rejection under section 103(a) can be established by considering Capiel in light of "common knowledge" or "well known" prior art. Applicants in numerous instances have requested that the Examiner cite a reference or alternatively provide an affidavit in support of his rejection as required under MPEP §2144.03.

MPEP §2144.03 provides:

"The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . [i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be

⁷ See second and last paragraph of "Attachment to Interview Summary of Paper No. 28," signed by Supervisory Patent Examiner Eric W. Stamber, dated June 23, 2003, attached as Exhibit 4.

⁸ MPEP §2144.03.

⁹ Office Action dated April 23, 2003, pages 4-19, 22-31, and Office Action dated November 27, 2002.

supported, when called for by the applicant, by an affidavit from the examiner.”¹⁰

Particularly, on page 8 of the Applicants’ response to the Office Action mailed November 27, 2002, the Applicants stated “[p]roviding supportive evidence is particularly important here because in every single page of the 30-page Office Action (and with respect to almost every claim), the Examiner has repeatedly relied on the “common knowledge” ... as the basis of rejection, without once offering any evidence to support this basis. Therefore, compliance with the provisions of MPEP §2144.03 and MPEP §2143 for *each instance* of rejection based on “common knowledge” is requested.” (emphasis in original).

The examiner in the Office Action mailed April 23, 2003, issued after the aforementioned Applicants request for supportive evidence, failed to provide any support, whatsoever, for the allegation of common knowledge. Without supportive evidence, there is no sufficient basis for establishing a prima facie case of obviousness. As such, it is respectfully submitted that, at least for this reason alone, the rejection of all claims should be withdrawn.

(B) The cited reference is non-analogous prior art.

It is respectfully submitted that the cited references, and particularly Capiel, are directed to non-analogous prior art. That is, in issuing the past five rejections, the Examiner has failed to cite any relevant prior art references that function in the same manner or produce the same results, as the claimed invention.

The criteria for determining whether prior art is analogous are twofold. First, one must determine whether the art is from the same *field of endeavor*, regardless of the problem addressed. Second, if the reference is not within the field of the inventor’s endeavor, one must determine whether the reference still is *reasonably pertinent to the “particular problem”* with which the inventor is involved.¹¹

Capiel “relates to the detection and monitoring of file formats which can be processed and displayed at an E-mail client.”¹² It is important to remember that the present invention uses email as a tool for delivery of its tracking technology and otherwise is unrelated to the format in which the email is forwarded or processed. That is, in the present invention, email is used only for forwarding a unique identifier to an email recipient. On the other, hand the main purpose of Capiel’s system is to determine whether email can be viably used, at all, as a means for delivery of certain file formats to a consumer.

To use an analogy, the present invention’s *field of endeavor* is more similar to a global positioning system (GPS), for example, that can efficiently track the entire route of travel of multiple vehicles,

¹⁰ See also MPEP §2143.

¹¹ *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

including all the details about the origins, the destinations and all the different paths traveled by the vehicles. Instead, Capiel's *filed of endeavor* is more similar to a survey system that uses a plurality of resources just to collect a single piece of data, *e.g.*, whether a vehicle is capable of using leaded or unleaded gasoline. Therefore, it is respectfully submitted that Capiel is not related to the field of endeavor of the present invention.

To make this clear, we refer to Capiel's Figures 1 and 2, attached as **Exhibit 5**, and column 3, lines 5-55. According to Capiel, a vendor computer system may want to forward promotional content in an email to an email client system. Email content may be produce in various formats such as in "plain text" or "HTML" format. It is more advantageous for a vendor to send promotional content in HTML format, however, because in addition to plain text visual elements such as pictures or logos can be also included.

The problem is that, unfortunately, not all email client systems are HTML enabled. That is, the email software utilized by certain email clients can only read plain text emails. Therefore, to overcome this problem, it is useful for a vendor to determine if an email client is HTML enabled, so that the promotional material can be forwarded accordingly.

Thus, the potential email clients are surveyed in advance so that it can be determined whether or not each email client can successfully read HTML content. The results of the survey are then collected into an email sensor database (132). These results simply produce one outcome, namely whether an email client machine is equipped with email reader software that can read HTML file formats.

Referring to Fig. 1 of Capiel, to accomplish the above, implementation of a special database server in an elaborate client-server network is required. The vendor system must communicate with an email sensor server (130) that in turn communicates with the email clients to determine system compatibility. In other words, an email sensor server (130) is needed to act as an intermediary between the vendor system and the email clients in order to send the survey requests and collect the responses.

Referring to columns 5, 6, and 7 of Capiel, technically, a test request or email is forwarded to each email client. Each email includes an HTML "image tag" (*i.e.*, 1 by 1 pixel gif image),¹³ which is included in a specially identified executable part 316 of the email.¹⁴ When an HTML enabled email client system opens the email, executable part 316 is automatically executed. As a result, the image tag passes to the

¹² See Abstract.

¹³ See col. 6, ln. 56 of Capiel.

¹⁴ See Figure 3, attached as Exhibit 5.

email sensor server (130) the “type and version of the email client software.”¹⁵ This information basically identifies if the email client is an HTML enabled system.¹⁶

Thus, the system of Capiel is *pertinent to* of identifying an HTML enabled client system. In contrast to Capiel, the present invention is *pertinent to* determining the details associated with the web surfing activities of an individual, regardless of the type of email software installed on the client system.

In fact, using the present invention, a user’s web surfing activities can be determined even if the user utilizes a different email client machine, each time the user accesses his or her email. In contrast, the system of Capiel fails if the user switches between computer systems or email software, because Capiel focuses on identifying email software installed on an email client machine. The present invention focuses on tracking the activities of the individual user, instead.

For the above reasons, the Applicant submits that the teachings of Capiel are neither within the same field of endeavor, nor reasonably pertinent to the particular problem solved by the present invention. Therefore, Capiel is an improper prior art reference.

(C) The present invention, as claimed, is patentably distinct from the cited reference and therefore is not obvious under Section 103(a).

MPEP §2143 provides:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

It is respectfully submitted that none of the aforementioned three basic criteria are met.

First, there is no motivation to modify Capiel to perform the claimed process and system of the present invention because Capiel uses a different method, configuration, and system structure to collect the necessary information.

For example, Capiel includes an image tag in a particular executable portion of an email. This is not equivalent to embedding a unique identifier into a website address, as claimed in the present invention. In Capiel, the image tag is automatically executed once the email is opened. This is not equivalent to a user actively selecting a web site address with the embedded unique identifier, as claimed in the present invention. Execution of the image tag of Capiel simply forwards certain file information to the email

¹⁵ See Col. 7, lns. 59-62 of Capiel.

¹⁶ See col. 5, lns. 5-16 of Capiel.

sensor server. In the present invention, selecting the web site address provides the user with access to one or more web sites.

In the system of Capiel, the email sensor server “serves as a middleman information collection point between the vendor systems . . . and the E-mail clients.”¹⁷ That is, the email sensor server is an integral part of system of Capiel, without which the system of Capiel would fail. The present invention does not require a middleman server for collecting the identifying information, however.

The email sensor server of Capiel collects information about whether an email client machine includes an HTML enabled email software.¹⁸ Therefore, the only data that the system of Capiel can collect is data that resides on the client side. In contrast, the claimed invention, causes a unique identifier to be automatically stored into a log file of the web server in association with other information that define consumer activity (see claim 2). According, the present invention does not require access to the client system; instead, information is retrieved from the server side.

Base on the above functional and structural distinctions and particularly because (1) the image tag of Capiel CANNOT provide (or be modified to provide) the email clients with access to other web sites, (2) the system of Capiel CANNOT practically function (or be modified to function) without an email sensor server, and (3) the system of Capiel MUST collect from the client side the necessary information and NOT from the server side, the Applicants respectfully submit that the claimed invention is patently distinct from the system Capiel.

Therefore, there is no likelihood that the system of Capiel can be successfully modified to perform the claimed process of the present invention or to achieve the same result. And even so, neither Capiel nor the knowledge generally available to one of ordinary skill in the art suggest a motivation to modify the teachings of Capiel in the direction of the present invention, particularly because there can be no reasonable expectation of success for such modification. For at least these reasons alone, it is submitted that the rejection of all pending claims should be withdrawn.

Notwithstanding the above, in the following we discuss in further detail why Capiel fails to teach or suggest all the claimed limitations in the present invention.

1. The Rejection of Claims 1, 22, 45, 52, 75, 78, and 81

Claims 1, 22, 45, and 52, 75, 78, and 81 are independent claims, with corresponding claims depending therefrom. Claims 1, 22, 45, and 52, 75, 78, and 81 are rejected under 35 U.S.C. § 103(a) as

¹⁷ See Col. 3, Ins. 15-21 of Capiel.

¹⁸ See col. 12, Ins. 63-65 of Capiel.

being unpatentable over Capiel.¹⁹ According to the Office Action, Capiel (col. 12, lns. 53-61; and col. 13, lns. 10-25) discloses a sensor server program with three parameters (1) E-mail address, (2) unique mail code and (3) member_id int. The Office Action then makes a sweeping reference to several other pages and Figures of Capiel, alleging that the cited sections disclose the claimed invention.

Unfortunately however, in the 39-page Office Action, not once is there an offer of proof on how the cited sections or the three cited parameters above are equivalent, associated, or suggest the claimed elements. Further, every page of the Office Action contains general allegations that are unsupported and merely continue to repeat the same general statement that the invention “would have been obvious to a person of ordinary skill in the art.” (See Office Action dated April 23, 2003, pages 4-19, 22-31)

We have reviewed all the cited sections of Capiel. Neither the cited sections, nor any other portion of Capiel discloses the present invention, as recited in claims 1, 22, 45, and 52, 75, 78, and 81. There is no teaching or suggestion in Capiel for “embedding a unique identifier within a web site address . . . [for] uniquely identifying an email recipient” so that the web surfing activities of the email recipient can be tracked on the particular web site.

The Examiner admits on page 4, paragraph 3 that Capiel fails to disclose several claimed elements. Yet again, instead of providing support on how such elements may be suggested by Capiel, the Examiner merely cites the same portions cited earlier.

As discussed above, and particularly referring to col. 7, lns. 34-63 of Capiel, the system of Capiel tracks file format compatibility by associating an identifier (i.e., “catid”) with an “image tag.” In contrast, in the present invention, as claimed, the tracking process is performed by embedding a unique identifier in a “web site address”. Capiel does not teach, disclose or suggest embedding a unique identifier in the web site address, because as discussed in detail earlier, Capiel’s system is not designed for providing access to web pages and cannot be modified to so.

The Examiner seems to suggest that the mere fact that the method of Capiel is executed on a computer and the possibility that the same computer can execute other software that provide access to a web site makes the claimed invention obvious. That is, the Examiner suggests that the two processes can be simply combined because the two can be executed on the same computer.

Respectfully, the Examiner has overlooked the fact that a computer is a general-purpose machine that can be used to concurrently but independently execute multiple software code. As such, the Examiner’s line of reasoning is flawed, because the fact that two independent processes can be executed on the same computer does not suggest that they can be combined. Otherwise, all computer-related inventions which utilize a combination of tools to achieve a certain result, would be obvious in light of other computer

¹⁹ Office Action dated April 23, 2003, pg. 3.

executable processes that can be executed independently to achieve completely different results.

Aside from the above, Capiel also fails to teach, suggest, or disclose:

“establishing a connection between a client computer used by the email recipient to receive the email and a *server computer providing access to the one or more web sites*, in response to the email recipient *selecting a reference* to the web site address included in the electronic mail message; *providing the unique identifier to the server computer* by way of sending the web site address to the server computer in a *request* submitted by the client computer *to access said one or more web sites*, independent from any consumer profile information previously stored on the client computer.” (emphasis added).

Apparently, the Examiner contends that the ‘email sensor server’ of Capiel is equivalent to the claimed “server computer” and that the ‘email client’ of Capiel is equivalent, to the claimed “client computer.” It is respectfully submitted, that while the present invention is directed to a client-server system, the claimed client and server computers are not equivalent to those of Capiel.

As discussed earlier, according to Capiel, the email client software establishes a connection with an ‘email sensor server’ not “a server computer providing access to the one or more web sites,” as claimed. Additionally, according to Capiel, the email client automatically executes the image tag upon opening an email. In contrast, in the present invention, the client computer establishes a connection with the server computer in response to the email recipient actively selecting a reference to a web site address.

The Examiner contends that the ‘catid’ included in the image tag is equivalent to the claimed “unique identifier” embedded in the web site address. As discussed earlier, the present invention does not utilize an image tag; and an image tag functions in a substantially different manner. That is, the image tag is automatically executed to send a response to a request submitted by the email sensor server, only if the email client is HTML enabled.²⁰ Otherwise, the “E-mail sensor server does not get an automatic response,”²¹ to its request from the email client.

In contrast to Capiel, the unique identifier of the present invention is forwarded “to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites.” As claimed, it is the client computer that submits a request to the server computer. Capiel teaches a reverse request-reply scenario.²²

Thus, the presently claimed invention of claims 1, 22, 45, and 52, 75, 78, and 81 is neither

²⁰ See col. 5, lns. 5-16, of Capiel.

²¹ See col. 5, lns. 30-32, of Capiel.

anticipated nor rendered obvious by the teachings of Capiel. The Examiner concedes this but argues that the system of Capiel can be modified based on the purported common knowledge. However, the basic deficiencies of Capiel are not remedied by resorting to “common knowledge” for which no support is provided by the Examiner.

Without the benefit of the Applicants’ disclosure, there would have been no incentive or reason for one of ordinary skill in the art to contemplate modifying the system of Capiel in any way based on common knowledge. The Court of Appeals for the Federal Circuit in Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc., 50 U.S.P.Q.2d 1641 (Fed. Cir. 1999), reaffirmed the enduring principle of obviousness that there must be some suggestion to combine elements that may exist independently in the prior art:

“[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988)

While the suggestion to combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge.²³

The combination/modification of teachings proposed by the Examiner simply is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner is impermissible hindsight reconstruction given the benefit of the Applicant’s disclosure.

Since obviousness may not be established by hindsight reconstruction or conjecture,²⁴ the rejection of claims 1, 22, 45, and 52, 75, 78, and 81 under 35 U.S.C. §103 based on the combined teachings of Capiel with common knowledge is improper and should be reversed.

2. The Rejection of Claims 2, 10, 23, 46, 76, 79, and 82

²² See col. 5, lns. 5-16, of Capiel.

²³ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

²⁴ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Dependent claims 2, 10, 23, 46, 76, 79, and 82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Capiel. The claims recite preferred features of the method and system of the invention for storing in at least one log file the unique identifier in association with the information that defines consumer activity; and extracting the information that defines consumer activity based on said association to track consumer movement.

The Examiner on page 5 of the Office Action, last paragraph, concedes that Capiel fails to disclose the above recited elements. The Examiner, however, alleges that common knowledge can be used to modify Capiel to include said elements. No further support for this allegation is provided.

For the reasons discussed above with respect to independent claims 1, 22, 45, and 52, 75, 78, and 81, since obviousness may not be established by hindsight reconstruction or conjecture, it is respectfully submitted that Capiel cannot be modified as alleged to include the recited elements here. Accordingly, the rejection of claims 2, 10, 23, 46, 76, 79, and 82 under 35 U.S.C. §103 based on the combined teachings of Capiel with common knowledge is improper and should be reversed.

3. The Rejection of Claims 3, 4, 24, 25, 47, 48, and 51

Dependent claims 3, 4, 24, 25, 47, 48, and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Capiel. The claims recite a preferred feature of the method and system of the invention wherein the act of associating the unique identifier with information that defines consumer activity comprises identifying connection specific information related to the established connection between the client computer and the one or more web sites, wherein the connection specific information is automatically logged in correspondence with the information that defines consumer activity; and associating the unique identifier with of the connection specific information such that information that defines consumer activity can be extracted based on the association between of the connection specific information and the unique identifier. The claimed connection specific information, in certain preferred embodiments, is the IP address²⁵ of the client computer, or the operating system²⁶ executing on the client computer.

The Examiner on pages 6 and 7 of the Office Action, concedes that Capiel fails to disclose the above recited elements. The Examiner, however, alleges that common knowledge can be used to modify Capiel to include said elements. No further support for this allegation is provided.

²⁵ See claims 3, 24, and 48.

²⁶ See Claim 51.

For the reasons discussed above with respect to independent claims 1, 22, 45, and 52, 75, 78, and 81, since obviousness may not be established by hindsight reconstruction or conjecture, it is respectfully submitted that Capiel cannot be modified as alleged to include the recited elements here. Accordingly, the rejection of claims 3, 4, 24, 25, 47, 48, and 51 under 35 U.S.C. §103 based on the combined teachings of Capiel with common knowledge is improper and should be reversed.

4. The Rejection of Claims 5, 26, and 50

Dependent claims 5, 26, and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Capiel. The claims recite a preferred embodiment of the invention in which the unique identifier is the email address of a consumer.

The Examiner on page 8 of the Office Action, concedes that Capiel fails to disclose the above recited elements. The Examiner, however, alleges that common knowledge can be used to modify Capiel to include said elements. No further support for this allegation is provided.

For the reasons discussed above with respect to independent claims 1, 22, 45, and 52, 75, 78, and 81, since obviousness may not be established by hindsight reconstruction or conjecture, it is respectfully submitted that Capiel cannot be modified as alleged to include the recited elements here. Accordingly, the rejection of claims 5, 26, and 50 under 35 U.S.C. §103 based on the combined teachings of Capiel with common knowledge is improper and should be reversed.

5. The Rejection of Claims 6-14, 27-35, and 80

Dependent claims 6-14, 27-35, and 80 recite various preferred features of the method and system of the invention reciting website content accessibility and web log content providing information about consumers behavior during a visit to the website, such as web pages visited and duration of visit.

The Examiner on pages 9-15 of the Office Action, concedes that Capiel fails to disclose the above recited elements. The Examiner, however, alleges that common knowledge can be used to modify Capiel to include said elements. No further support for this allegation is provided.

For the reasons discussed above with respect to independent claims 1, 22, 45, and 52, 75, 78, and 81, since obviousness may not be established by hindsight reconstruction or conjecture, it is respectfully submitted that Capiel cannot be modified as alleged to include the recited elements here. Accordingly, the rejection of claims 6-14, 27-35, and 80 under 35 U.S.C. §103 based on the combined teachings of Capiel with common knowledge is improper and should be reversed.

6. The Rejection of Claims 15-21, 36-44, 49 and 77

Dependent claims 15-21, 36-44, 49 and 77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Capiel. The claims recite various preferred features of the method and system of the invention further comprising developing a consumer master database based upon the log file; querying the master database; and determining consumer preferences. The master database, in certain embodiments is constructed to comprise various segments including consumer related information such as email, promotional material, purchases, URLs associated with key codes and keywords, and credit card data.

The Examiner on pages 15-31 of the Office Action, concedes that Capiel fails to disclose the above recited elements. The Examiner, however, alleges that common knowledge can be used to modify Capiel to include said elements. No further support for this allegation is provided.

For the reasons discussed above with respect to independent claims 1, 22, 45, and 52, 75, 78, and 81, since obviousness may not be established by hindsight reconstruction or conjecture, it is respectfully submitted that Capiel cannot be modified as alleged to include the recited elements here. Accordingly, the rejection of claims 15-21, 36-44, 49 and 77 under 35 U.S.C. §103 based on the combined teachings of Capiel with common knowledge is improper and should be reversed.

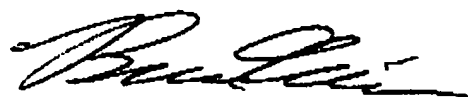
CONCLUSION

The prior art of record, considered singly or collectively, fails to disclose or in any way suggest Applicants claimed invention. Accordingly, appealed claims 1-52 and 75-82 should be allowed.

This Appeal Brief is submitted herewith in triplicate along with an Appendix of the appealed claims and the requisite fee for filing the Appeal Brief.

Please feel free to forward any questions and comments to the undersigned, at the phone number (310) 789 2100.

Respectfully submitted,



Bruce Eisen, CEO UserTrends, Inc.
Representative for Applicant(s)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to:

Mail Stop: NOTICE OF APPEAL
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

on September 19, 2003.

F. Jason Far-hadian, Esq.

9-19-2003

Date of Signature

Respectfully submitted,



F. Jason Far-hadian, Esq.
Attorney for Applicant(s)
Reg. No. 42,523



APPENDIX OF CLAIMS ON APPEAL

1. A method for electronically identifying a consumer without requiring consumer registration, the method comprising:

embedding a unique identifier within a web site address, the unique identifier uniquely identifying an email recipient;

including the web site address in an electronic mail message sent to the email recipient, wherein the web site address provides the email recipient with access to one or more web sites;

establishing a connection between a client computer used by the email recipient to receive the email and a server computer providing access to the one or more web sites, in response to the email recipient selecting a reference to the web site address included in the electronic mail message;

providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer;

parsing the web site address in the request, to retrieve the unique identifier embedded in the web site address;

identifying the email recipient based on the retrieved unique identifier; and

tracking the email recipient's movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.

2. The method of Claim 1, wherein the act of tracking the email recipient's movement within said one or more web sites comprises:

storing in at least one log file the unique identifier in association with the information that defines consumer activity; and

extracting the information that defines consumer activity based on said association to track consumer movement.

3. The method of Claim 1, wherein the act of associating the unique identifier with information that defines consumer activity comprises:

identifying an IP address of the client computer, wherein the IP address is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with the IP address such that the information that defines consumer activity can be extracted based on the association between the IP address and the unique identifier.

4. The method of Claim 1, wherein the act of associating the unique identifier with information that defines consumer activity comprises:

identifying connection specific information related to the established connection between the client computer and the one or more web sites, wherein the connection specific information is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with of the connection specific information such that information that defines consumer activity can be extracted based on the association between of the connection specific information and the unique identifier.

5. The method according to Claim 1, wherein the unique identifier identifies a consumer's electronic mail address.

6. The method according to Claim 1, wherein the one or more web sites include a plurality of links to other web pages located at a plurality of web servers.

7. The method according to Claim 6, wherein the plurality of links to other web pages includes a link to a web page from where the consumer purchases merchandise.

8. The method according to Claim 6, wherein the plurality of links to other web pages includes a link to a web page from where the consumer electronically views images of

merchandise.

9. The method according to Claim 6, wherein the plurality of links to other web pages includes a link to a web page from where the consumer electronically contacts a seller.

10. The method according to Claim 1, wherein information about the consumer's movement within the one or more web sites is stored in a log file.

11. The method according to Claim 10, wherein the log file includes the addresses of the one or more web sites.

12. The method of Claim 10, wherein the log file includes information regarding number of times the consumer accesses a particular web site.

13. The method of Claim 10, wherein the log file includes information regarding any purchase the consumer makes while visiting the one or more web site.

14. The method according to Claim 10, wherein the log file includes duration of the consumer's visit to a particular web site.

15. The method according to Claim 10, further comprising:
developing a consumer master database based upon the log file;
querying the master database; and
determining consumer preferences.

16. The method according to Claim 15, wherein the master database includes a plurality of segments including an email look up segment that includes a listing of a plurality of

consumer electronic mail addresses with corresponding unique identifiers.

17. The method according to Claim 15, wherein the master database includes a consumer information segment that contains consumer related information.

18. The method according to Claim 15, wherein the master database includes a promotional material segment that includes information regarding promotional materials.

19. The method according to Claim 15, wherein the master database includes a purchasing segment that includes information regarding purchases made by the consumers.

20. The method according to Claim 15, wherein the master database includes a URL segment that includes a plurality of URLs with corresponding keywords and plurality of keycodes associated with the keywords.

21. The method according to Claim 15, wherein the master database includes a credit card segment that includes consumer credit card number, date and amount of purchase by consumer.

22. Computer executable process stored in a computer readable medium for identifying a consumer without requiring consumer registration, the process comprising:

embedding a unique identifier within a web site address, the unique identifier uniquely identifying a consumer;

establishing a connection between the consumer's computer and a server computer providing access to one or more web sites, in response to a consumer selecting a reference to the web site address forwarded by way of electronic mail;

providing the unique identifier to the server computer by way of sending the website address to the server computer to access the one or more web sites, independent from any

consumer profile information previously stored on the client computer;

parsing the web site address to retrieve the unique identifier embedded in the web site address; and

tracking the consumer's movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.

23. The computer executable process of Claim 22, wherein the act of tracking consumer movement within said one or more web sites comprises:

storing in a log file the unique identifier in association with the information that defines consumer activity within said one or more web sites;

searching the log file for the unique identifier; and

extracting the information that defines consumer activity based on its association with the unique identifier to track consumer movement.

24. The computer executable process of Claim 22, wherein the act of associating the unique identifier with information that defines consumer activity comprises:

identifying an IP address used for establishing the connection between the consumer's computer and the one or more web sites, wherein the IP address is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with the IP address such that the information that defines consumer activity can be extracted based on the association between the IP address and the unique identifier.

25. The computer executable process of Claim 22, wherein the act of associating the unique identifier with information that define consumer activity comprises:

identifying connection specific information related to the established connection between the consumer's computer and the one or more web sites, wherein the connection specific

information is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with the connection specific information such that data that defines consumer activity can be extracted based on the association between the IP address and the unique identifier.

26. Computer executable process steps according to Claim 22, wherein the unique identifier identifies a consumer's electronic mail address.

27. (Amended) Computer executable process steps according to Claim 22, wherein the one or more web sites include a plurality of links to other web pages located at a plurality of web servers.

28. Computer executable process steps according to Claim 27, wherein the plurality of links to other web pages located at a plurality of web servers includes a link to a web page from where the consumer can purchase merchandise.

29. Computer executable process steps according to Claim 27, wherein the plurality of links to other web pages includes a link to a web page from where the consumer can electronically view images of merchandise.

30. Computer executable process steps according to Claim 27, wherein the plurality of links to other web pages includes a link to a web page from where the consumer may electronically contact a seller.

31. Computer executable process steps according to Claim to 22, wherein information about the consumer's movement within the one or more web sites is stored in a log file.

32. Computer executable process steps according to Claim according to 31, wherein the log file includes the addresses of the one or more web sites.

33. Computer executable process steps according to Claim 31, wherein the log file includes information regarding number of times the consumer accesses a particular web site.

34. Computer executable process steps according to Claim 31, wherein the log file includes information regarding any purchase the consumer makes while visiting the one or more web site.

35. Computer executable process steps according to Claim 31, wherein the log file includes the duration of the consumer's visit to a particular web site.

36. Computer executable process steps according to Claim 31, further comprising:
developing a consumer master database based upon the log file;
querying the master database; and
determining consumer preferences.

37. Computer executable process steps according to Claim 36, wherein the master database includes a plurality of segments including an email look up segment that includes a listing of a plurality of consumer electronic mail addresses with corresponding unique identifiers.

38. Computer executable process steps according to Claim 36, wherein the master database includes a consumer information segment that contains consumer related information.

39. Computer executable process steps according to Claim 36, wherein the master database includes a promotional material segment that includes information regarding promotional

materials.

40. Computer executable process steps according to Claim 36, wherein the master database includes a purchasing segment that includes information regarding purchases made by the consumers.

41. Computer executable process steps according to Claim 36, wherein the master database includes a URL segment for storing plurality of keywords associated with plurality of URLs, and the plurality of key codes associated with plurality of keywords.

42. Computer executable process steps according to Claim 36, wherein the master database includes a credit card segment that includes consumer credit card number, date and amount of purchase by consumer.

43. The method of Claim 1, wherein the unique identifier is a consumer's credit card information.

44. The computer executable process of Claim 22, wherein the unique identifier is a consumer's credit card information.

45. A method for electronically identifying a consumer without requiring consumer registration, the method comprising:

receiving a consumer request to access one or more web sites implemented on at least one server computer, wherein the consumer request is submitted by way of a client computer and the request includes a web site address, sent to the consumer in an electronic mail message, with a unique identifier embedded in the web site address for uniquely identifying the particular consumer;

parsing the web site address to find the unique identifier; and

logging the unique identifier in one or more log files in association with information that defines consumer activity within said one or more web sites, independent from any consumer profile information previously stored on the client computer by any servers.

46. The method of Claim 45, further comprising:

extracting the information that defines consumer activity based on its association with the unique identifier to track consumer movement.

47. The method of Claim 45, wherein the consumer request is received through a connection established between the consumer's computer and the one or more web sites, the method further comprising:

identifying at least one of connection and environment specific information related to the established connection between the consumer's computer and the one or more web sites, wherein at least one of the connection and environment specific information is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with at least one of the connection and environment specific information such that information that defines consumer activity can be extracted based on the association between at least one of the connection and environment specific information and the unique identifier.

48. The method of Claim 47, wherein at least one of the connection and environment specific information relates to IP address of the consumer's computer.

49. The method of Claim 47, wherein the unique identifier relates to credit card information of the consumer.

50. The method of Claim 47, wherein the unique identifier relates to electronic mail address of the consumer.

51. The method of Claim 47, wherein at least one of the connection and environment specific information relates to an operating system executing on the consumer's computer.

52. A unique identifier embedded in a URL provided to a consumer by way electronic mail, such that when the consumer selects the URL a connection is established between a consumer computer having a first IP address and a web server providing access to one or more web sites, wherein the web server receives the URL via said established connection independent from any consumer profile information previously stored on the client computer, wherein the web server parses the URL for the unique identifier, and wherein the IP address is recorded in a log file in association with the unique identifier.

75. A computer-implemented method for electronically tracking web pages visited by an email recipient without requiring advanced registration, the method comprising:

embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages;

including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages;

establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL;

providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded;

parsing the URL in the request to retrieve the unique identifier embedded in the URL;

identifying the email recipient based on the retrieved unique identifier;

automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and

automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

76. The computer-implemented method of Claim 75, further comprising:

extracting the access information for a particular email recipient by cross-referencing the IP address of the client computer used by the particular email recipient with respective access information and unique identifier stored in the log file in association with the IP address.

77. The computer-implemented method of Claim 75, wherein the access information comprises at least one of: an address of a web page visited by the email recipient, duration of the visit, and purchase information during of the visit.

78. A computer system for electronically tracking web pages visited by an email recipient without requiring advanced registration, the system comprising:

means for embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages;

means for including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages;

means for establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL;

means for providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded;

means for parsing the URL in the request to retrieve the unique identifier embedded in the URL;

means for identifying the email recipient based on the retrieved unique identifier;

means for automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and

means for automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

79. The computer system of Claim 78, further comprising:

means for extracting the access information for a particular email recipient by cross-referencing the IP address of the client computer used by the particular email recipient with respective access information and unique identifier stored in the log file in association with the IP address.

80. The computer system of Claim 78, wherein the access information comprises at least one of: an address of a web page visited by the email recipient, duration of the visit, and purchase information during of the visit.

81. A computer-readable medium comprising a computer-executable process stored for electronically tracking web pages visited by an email recipient without requiring advanced registration, the computer-executable process comprising:

embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages;

including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages;

establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL;

providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information

previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded;

 parsing the URL in the request to retrieve the unique identifier embedded in the URL;

 identifying the email recipient based on the retrieved unique identifier;

 automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and

 automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

82. The computer-readable medium of claim 81, wherein the computer-executable process further comprises:

 extracting the access information for a particular email recipient by cross-referencing the IP address of the client computer used by the particular email recipient with respective access information and unique identifier stored in the log file in association with the IP address,

 wherein the access information comprises at least one of: an address of a web page visited by the email recipient, duration of the visit, and purchase information during of the visit.



5/10

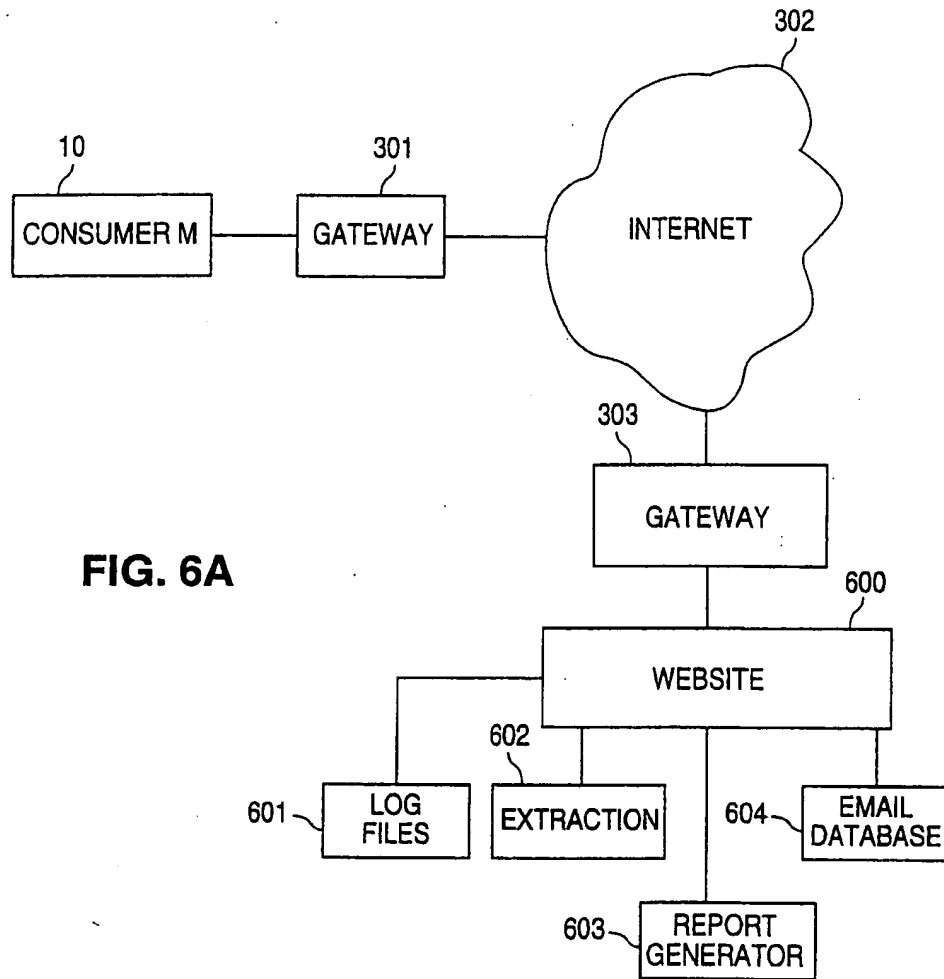


FIG. 6A

To: CONSUMERM@dgo.com 604
From: RETAIL STORE 605
Re: Promotional material

<http://www.mystore.com/?XXXX> 606

FIG. 6B

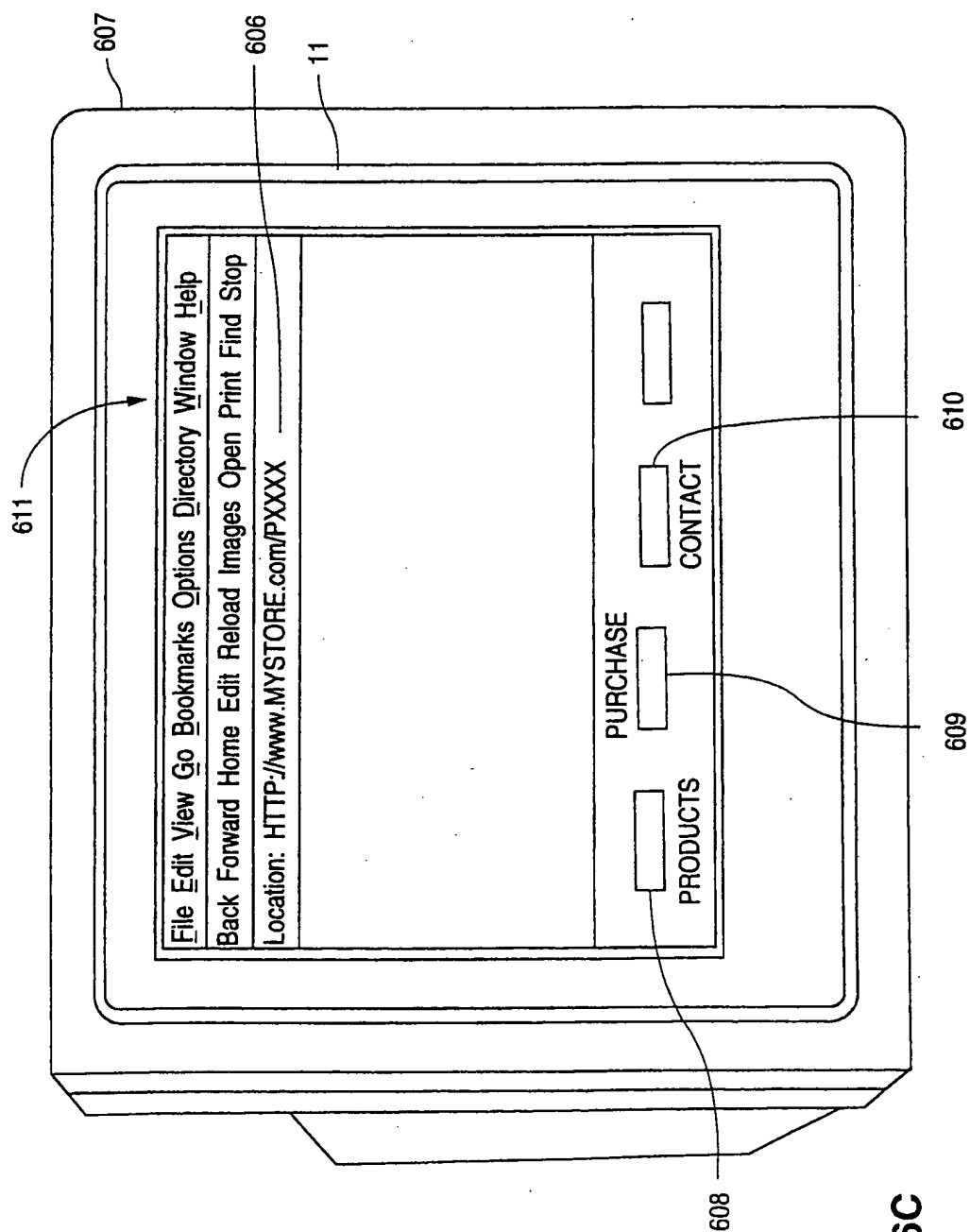


FIG. 6C

FIG. 7A

701 IP NUMBER	702 DATE AND TIME	703 URL
202.247.132.194 - -	[02/Jun/1999:16:13:02 -0700]	"GET/email/index.html?UTID=XXXX&UTPN=5678&UTSN=9876
HTTP/1.1" 200 3503		
207.247.132.194 - -	[02/Jun/1999:16:13:02 -0700]	"GET/email/img/quick.GIF HTTP/1.1" 200 2411
207.247.132.194 - -	[02/Jun/1999:16:13:03 -0700]	"GET/email/img/go.gif HTTP/1.1" 200 240
207.247.132.194 - -	[02/Jun/1999:16:13:03 -0700]	"GET/email/img/order.GIF HTTP/1.1" 200 3364
207.247.132.194 - -	[02/Jun/1999:16:13:03 -0700]	"GET/email/img/line.GIF HTTP/1.1" 200 79
207.247.132.194 - -	[02/Jun/1999:16:13:04 -0700]	"GET/email/img/logo.GIF HTTP/1.1" 200 2628
207.247.132.194 - -	[02/Jun/1999:16:13:05 -0700]	"GET/email/img/products.GIF HTTP/1.1" 200 93286
207.247.132.194 - -	[02/Jun/1999:16:13:09 -0700]	"GET/email/bottom.htm HTTP/1.1" 200 910
207.247.132.194 - -	[02/Jun/1999:16:13:09 -0700]	"GET/email/img/bg.GIF HTTP/1.1" 200 99
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2159		
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207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/link_fashion.gif HTTP/1.1" 200 2067
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207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/link_furniture.gif HTTP/1.1" 200
2171		
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/links.gif HTTP/1.1" 200 674
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/h_computers.GIF HTTP/1.1" 200 7555
207.247.132.194 - -	[02/Jun/1999:16:13:13 -0700]	"GET
/email/EmblazeVideoPro/computerv_toshiba_notebook.htm	HTTP/1.1" 200 1971	
207.247.132.194 - -	[02/Jun/1999:16:13:14 -0700]	"GET/email/img/movieframe.gif HTTP/1.1" 200 482

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Bruce Eisen et al.

Assignee: User Trends, Inc.

Title: Electronically Distributing Promotional And Advertising Material
Based Upon Consumer Internet Usage

Serial No.: 09/379,167 Filing Date: 08/23/99

Examiner: John L. Young Group Art Unit: 2162

Docket No.: M-7729 US

Assistant Commissioner of Patents
Washington, D.C. 20231

DECLARATION OF BRUCE EISEN

I, Bruce Eisen, the undersigned declare as follows:

1. I am the [your title] of UserTrends corporation. UserTrends is a privately held company headquartered in Los Angeles, California, which has developed proprietary e-mail marketing personalization solutions for both traditional and online retailers.
2. I have been in the email marketing industry for approximately ??? years. In my capacity as the [your title] of UserTrends, I make decisions involving [. . . .]. Based on my background and experience in the industry, the scope of my duties as the [your title] of UserTrends, my personal experience with UserTrends technology, and my knowledge of other technologies in the email marketing industry, I provide you the following professional opinion.
3. UserTrends data collection tools help companies learn about and precisely target individual customer interests. These solutions enable marketers to generate higher response rates to promotions, save on marketing costs, and increase sales and profits---all, while building a loyal customer base.

4. UserTrends' technology is different from cookie profiling and other email consumer profiling technologies for the following reasons: (1) UserTrends' technology accurately profiles a particular individual's interests and preferences by focusing on a known identifier associated with that particular individual, rather than using unanimous identifying means (i.e., a cookie) typically associated with a computer used by the individual, (2) UserTrends' technology does not require storage of a unique identifier on the client computer at any time and therefore does not require use of a certain "cookie handling feature" provided in a browsing software, (3) UserTrends' technology does not require authorized access to the client computer to retrieve information in a cookie file, (4) because of the above advantages implementation of UserTrends' technology requires substantially less resources and no or minimal customization and is substantially less expensive, and (5) UserTrends' technology does not burden the targeted audience to go through a lengthy or inconvenient registration process.

5. Competing electronic consumer profiling technologies generally capture individual data via an unfriendly registration process or by requiring a visitor logging in to the site or making a purchase. The e-marketing industry has generally used such data for mass direct marketing campaigns. In the case of data collected through a lengthy registration process, which only reveals a consumer's interest at a *particular moment* in time, aggregate profiling is usually necessary to determine what promotions to send the consumer.

6. Various competing profiling methods and their disadvantages when compared to UserTrends' technology are provided below:

Purchase Profiling - While purchase profiling is an accurate way of determining one interest of a customer, it isn't able to relate the customer's interests with other products they looked at but did not purchase. UserTrends' technology doesn't require a purchase or input of sensitive financial information to collect behavior data.

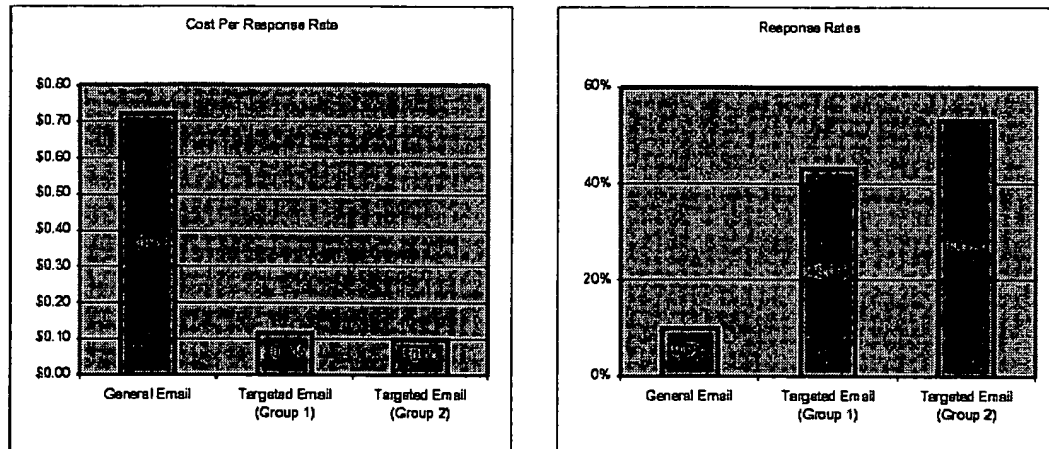
Registration Profiling - This requires individuals to take the time to fill out a long survey to provide marketers with some data regarding their particular interests. Unfortunately, the accuracy and reliability of such collected data are often questionable. These surveys can also often fail to weigh customer interests and only represent interests at one remote instance — although interests change, registrations remain the same. UserTrends'

technology does not require a burdensome registration and allows updating users' interest data based on each individual user's activities on various web pages.

Cookie Profiling – Although many websites employ cookie technology to capture some group and individual data, the identity of the website user remains anonymous. This is because a cookie can be only associated with a computer system and not an individual. Those who regard cookies as invasive erase them or block a web server from storing cookies on their computers. This makes it difficult, if not impossible, for marketers to acquire a consistent and individual profile. Without the need for cookies or the need for accessing client computer, UserTrends' technology collects, identifies, and tracks individual data transparently for profiling and marketing purposes.

7. In particular, cookie profiling technology requires modification and customization of websites so that web servers can successfully access and store a cookie on an end user's computer. Further, customization and modifications are required to accommodate the cookie handling features of various browser applications used by an end user so that the cookie profiling technology could work effectively across all systems and platforms. Customization of each website or web server is associated with high professional service fees and requires more sophisticated computing resources (e.g., software and hardware).
8. UserTrends' technology simply relies on preexisting email-associated resources and uses an email campaign that does not rely on customized web sites, sophisticated web servers, cookies or compatibility with cookie handling features of various browsers to collect highly individualized data. All that is required is an individual's email address and the individual's capability to receive email. The simplicity of UserTrends' technology provides a very efficient profiling technology that has convinced many UserTrends' clients to abandon other costly methodologies and solutions used previously.
9. The data collected via a cookie profiling technology cannot be directly associated with a particular user or email because a cookie profiling technology only provides information about the computer used and not the particular user. Where more than one individual uses the same computer, or where an individual uses more than one computer, cookie profiling technology does not provide accurate behavior patterns that are so valuable for targeted marketing.

10. UserTrends' technology allows association of an email campaign data to each individual's email address and does not depend on anonymous data (i.e., data that provides an association of behavior to a specific computer rather than to an individual). Our studies have shown that as a direct result of using Usertrands' technology higher response rates and conversion rates have been achieved from email campaigns by our clients over time as illustrated in the following charts.



11. Other email marketers have failed in targeting promotions to demonstrated web-site behavior down to the individual and therefore cannot accurately individualize the result of the information gathered from monitoring user movement on the Internet. UserTrends' technology addresses this long-felt need to solve the above deficiencies and problems. Utilizing UserTrends' technology targeted email promotions to individuals can be achieved, instead of executing mass marketing campaigns or marketing to large groups.

12. Utilizing UserTrends' technology has reduced professional service requirements of UserTrends' clients by more than 50%. This cost saving and efficiency in particular is due to ease of implementation and use of the Usertrands' technology because it does not require special "customization" of server systems and website servers that other cookie or registration profiling technologies require.

13. UserTrends has negotiated and is currently negotiating licensing arrangements with a number of current clients and other email marketing vendors to license UserTrends' proprietary technology. Majority of the license agreements are to vendors who "resell" the technology to

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PAGE 06

13. UserTrends has negotiated and is currently negotiating licensing arrangements with a number of current clients and other email marketing vendors to license UserTrends' proprietary technology. Majority of the license agreements are to vendors who "resell" the technology to their clients. Cable and Wireless (CWP), Xpedite (PTEK), Boldfish, and eContacts are among the vendors who have used UserTrends technology and have licensed or are considering licensing the technology. Many clients of these vendors have already used UserTrends' technology. These clients include HP, Compaq, Hawaiian Airlines, One World Networks, and CarrierPath.


14. The above information provides objective evidence of unexpected results, commercial success, the ability to meet a long-felt need where others have failed, and other factual evidence in relation to UserTrends' technology, such as licensing activities. This evidence when considered collectively indicates that UserTrends technology has been used to provide a distinct and novel solution to overcome an insoluble problem associated with the older electronic profiling technologies discussed above.

15. I hereby declare that all statements made herein are of my own knowledge and true, and that all said statements are made on information and belief and are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code,¹ and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: November 14, 2002

By:


CEO, USERTRENDS

¹ (a) Except as otherwise provided in this section, whenever, in any matter within the jurisdiction of the executive, legislative, or judicial branch of the Government of the United States, knowingly and willfully -
(1) falsifies, conceals, or covers up by any trick, scheme, or device a material fact;
(2) makes any materially false, fictitious, or fraudulent statement or representation; or
(3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry, shall be fined under this title or imprisoned not more than 5 years, or both.
(b) Subsection (a) does not apply to a party to a judicial proceeding, or that party's counsel, for statements, representations, writings or documents submitted by such party or counsel to a judge or magistrate in that proceeding.
(c) With respect to any matter within the jurisdiction of the legislative branch, subsection (a) shall apply only to -
(1) individual or corporate, including a claim for payment, a matter related to the procurement of property or services, personnel or employment practices, or support services, or a document required by law, rule, or regulation to be submitted to the Congress or any officer or official within the legislative branch; or
(2) any investigation or review, conducted pursuant to the authority of any committee, subcommittee, conference or office of the Congress, consistent with applicable rules of the House or Senate.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Bruce Eisen et al.
Assignee: User Trends, Inc.
Title: Electronically Distributing Promotional And Advertising Material
Based Upon Consumer Internet Usage
Serial No.: 09/379,167 Filing Date: 08/23/99
Examiner: John L. Young Group Art Unit: 2162
Docket No.: M-7729 US

Assistant Commissioner of Patents
Washington, D.C. 20231

DECLARATION OF JAMES FEDOLFI

I, James Fedolfi, the undersigned declare as follows:

1. I am the Vice President of EContacts Corporation. eContacts is a worldwide email marketing company with a place of business in Boston, Massachusetts. eContacts provides enabling solutions to companies involved in permission email marketing and traditional marketing. Our clients include Fortune 500 companies (e.g., HP, D&B, Red Herring, etc.) in a variety of industries.
2. I have been in the email marketing industry with eContacts for approximately 4 years. In my capacity as the vise-president of eContacts, I make decisions involving the purchase, licensing, and utilization of technological tools to advance and promote eContacts' business and scope of influence in the current highly competitive electronic economic market. In that capacity, I am also involved in the management of business and financial operations of eContacts and overlook the development and success of eContacts and its client's marketing campaigns and evaluate the efficiency and effectiveness of technological tools used to achieve the same. Based on my background and experience in the industry, the scope of my duties as the Vice President of

eContacts, my personal experience with UserTrends technology, and my knowledge of other technologies in the email marketing industry, I provide you the following professional opinion.

3. eContacts has been using UserTrends' proprietary electronic consumer profiling technology since 2001 to track and profile consumer behavior. Prior to using UserTrends', eContacts had utilized other electronic profiling technologies to track particular consumer interests and profiles. Among all the technologies used by eContacts, UserTrends' technology was most the efficient and effective in providing our email marketing clients with a solution for profiling email respondents web site behavior and targeted email campaigns.

4. UserTrends' technology is unique and superior to the other solutions and technologies we have used for the following reasons: (1) UserTrends' technology provides email marketers with data that cannot be otherwise collected with use of cookies (2) implementation of UserTrends' technology requires substantially less resources, (3) UserTrends' technology can be implemented with ease requiring no or minimal customization, (4) integration and use of UserTrends' technology is substantially less expensive than the other competing products in the market, (5) UserTrends' technology does not burden the targeted audience to go through a lengthy or inconvenient registration process, (6) UserTrends' technology accurately profiles a particular individual's interests and preferences by focusing on a known identifier associated with that particular individual, rather than using unanimous identifying means typically associated with a computer used by the individual.

5. Competing electronic consumer profiling technologies generally capture individual data via an unfriendly registration process or by requiring a visitor logging in to the site or making a purchase. The e-marketing industry has generally used such data for mass direct marketing campaigns. In the case of data collected through a lengthy registration process, which only reveals a consumer's interest at a *particular moment* in time, aggregate profiling is usually necessary to determine what promotions to send the consumer. The following provides a list of various competing profiling methods and their disadvantages when compared to UserTrends' technology:

Purchase Profiling - While purchase profiling is an accurate way of determining one interest of a customer, it isn't able to relate the customer's interests with other products

they looked at but did not purchase. UserTrends' technology doesn't require a purchase or input of sensitive financial information to collect behavior data.

Registration Profiling – This requires individuals to take the time to fill out a long survey to provide marketers with some data regarding their particular interests. Unfortunately, the accuracy and reliability of such collected data are often questionable. These surveys can also often fail to weigh customer interests and only represent interests at one remote instance – although interests change, registrations remain the same. UserTrends' technology does not require a burdensome registration and allows updating users' interest data based on each individual user's activities on various web pages.

Cookie Profiling – Although many websites employ cookie technology to capture some group and individual data, the identity of the website user remains anonymous. This is because a cookie can be only associated with a computer system and not an individual. Those who regard cookies as invasive erase them or block a web server from storing cookies on their computers. This makes it difficult, if not impossible, for marketers to acquire a consistent and individual profile. Without the need for cookies, UserTrends collects, identifies, and tracks individual data transparently for profiling and marketing purposes.

6. In particular, with respect to our clients, cookie profiling technology required our clients to modify and customize their websites so that their web servers could successfully access and store a cookie on an end user's computer. Further, customization and modifications were required to accommodate the cookie features of various browser applications used by an end user so that the cookie profiling technology could work effectively across all systems and platforms. Customization of each website or web server is associated with high professional service fees and requires more sophisticated computing resources (e.g., software and hardware).
7. UserTrends' technology simply relies on preexisting email-associated recourses and uses an email campaign that does not rely on customized web sites, sophisticated web servers, cookies or availability of cookie handling features of various browsers to collect highly individualized data. All that is required is an individual's email address and the individual's capability to receive email. The simplicity of UserTrends' technology has provided eContacts with a very

efficient profiling technology that has convinced eContacts to abandon other costly methodologies and solutions used previously.

8. Unfortunately, even with all the required customization and other associated overhead, data collected via a cookie profiling technology cannot be directly associated with a particular user or email because a the cookie profiling technology only provides information about the computer used and not the particular user. Where more than one individual uses the same computer, or where an individual uses more than one computer, cookie profiling technology does not provide accurate behavior patterns that are so valuable for targeted marketing.
9. UserTrends' technology allows us to associate email campaign data to each individual's email address and not depend on anonymous data (i.e., data that provides an association of behavior to a specific computer rather than to an individual). *The results have been astounding.* For example, as a direct result of using Usertrands' technology, we have achieved 25% to 35% higher response rates and conversion rates from email campaigns over time because a marketer is able to personalize and target promotions to individual preferences and demonstrated interest.
10. UserTrends' technology has been so commercially successful, that we have been able to win business away from our competitors who cannot bring added value to the email marketers by providing them with highly individualized consumer data.
11. Other email marketers have failed in targeting promotions to demonstrated web-site behavior down to the individual and therefore cannot accurately individualize the result of the information gathered from monitoring user movement on the Internet. UserTrends' technology addresses this long-felt need to solve the above deficiencies and problems. Utilizing UserTrends' technology now we can target email promotion to individuals instead of executing mass marketing campaigns or marketing to large groups.
12. Utilizing UserTrends' technology, we have successfully reduced our professional service requirements by more than 50%. This cost saving and efficiency in particular is due to ease of implementation and use of the Usertrends' technology because it does not require special "customization" of server systems and website servers that other cookie or registration profiling technologies require.

13. I hope that the above information will assist to shed some light on the usefulness of UserTrends' distinctive technology. I hereby declare that all statements made herein are of my own knowledge and true, and that all said statements are made on information and belief and are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code,¹ and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: November 13, 2002

By:

James Fedolfi, VP eContacts, Inc.

¹

(a) Except as otherwise provided in this section, whoever, in any matter within the jurisdiction of the executive, legislative, or judicial branch of the Government of the United States, knowingly and willfully -

- (1) falsifies, conceals, or covers up by any trick, scheme, or device a material fact;
- (2) makes any materially false, fictitious, or fraudulent statement or representation; or
- (3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry;

shall be fined under this title or imprisoned not more than 5 years, or both.

(b) Subsection (a) does not apply to a party to a judicial proceeding, or that party's counsel, for statements, representations, writings or documents submitted by such party or counsel to a judge or magistrate in that proceeding.

(c) With respect to any matter within the jurisdiction of the legislative branch, subsection (a) shall apply only to -

(1) administrative matters, including a claim for payment, a matter related to the procurement of property or services, personnel or employment practices, or support services, or a document required by law, rule, or regulation to be submitted to the Congress or any office or officer within the legislative branch; or

(2) any investigation or review, conducted pursuant to the authority of any committee, subcommittee, commission or office of the Congress, consistent with applicable rules of the House or Senate.

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NOV-18-2002 03:05 PM USA COMMUNICATIONS 617+886+2200

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PAGE 85

Respectfully submitted,

Date: November 13, 2002

By: 
James H. Smith, VP of Corporate Sales

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Interview Summary

Application No.

09/379,167

Applicant(s)

EISEN ET AL.

Examiner

YOUNG

Group Art Unit

3622

All participants (applicant, applicant's representative, PTO personnel):

(1) ERIC STAMBER (SPE)(3) BRUCE EISEN (APPLICANT)(2) JASON FAR-HADIAN (APPLICANT'S REP.)(4) JAMES LUCAS (APPLICANT)Date of Interview 6/23/03Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).Exhibit shown or demonstration conducted: ☒ Yes ☐ No. If yes, brief description:INTERVIEW OUTLINE SUBMITTED BY MR. FAR-HADIAN (ATTACHED)Agreement ☐ was reached. ☒ was not reached.Claim(s) discussed: 1 (REPRESENTATIVE)

Identification of prior art discussed:

CAPIEL (US 6,449,634)

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

SEE ATTACHED

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☒ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Eric W. Stamber
ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

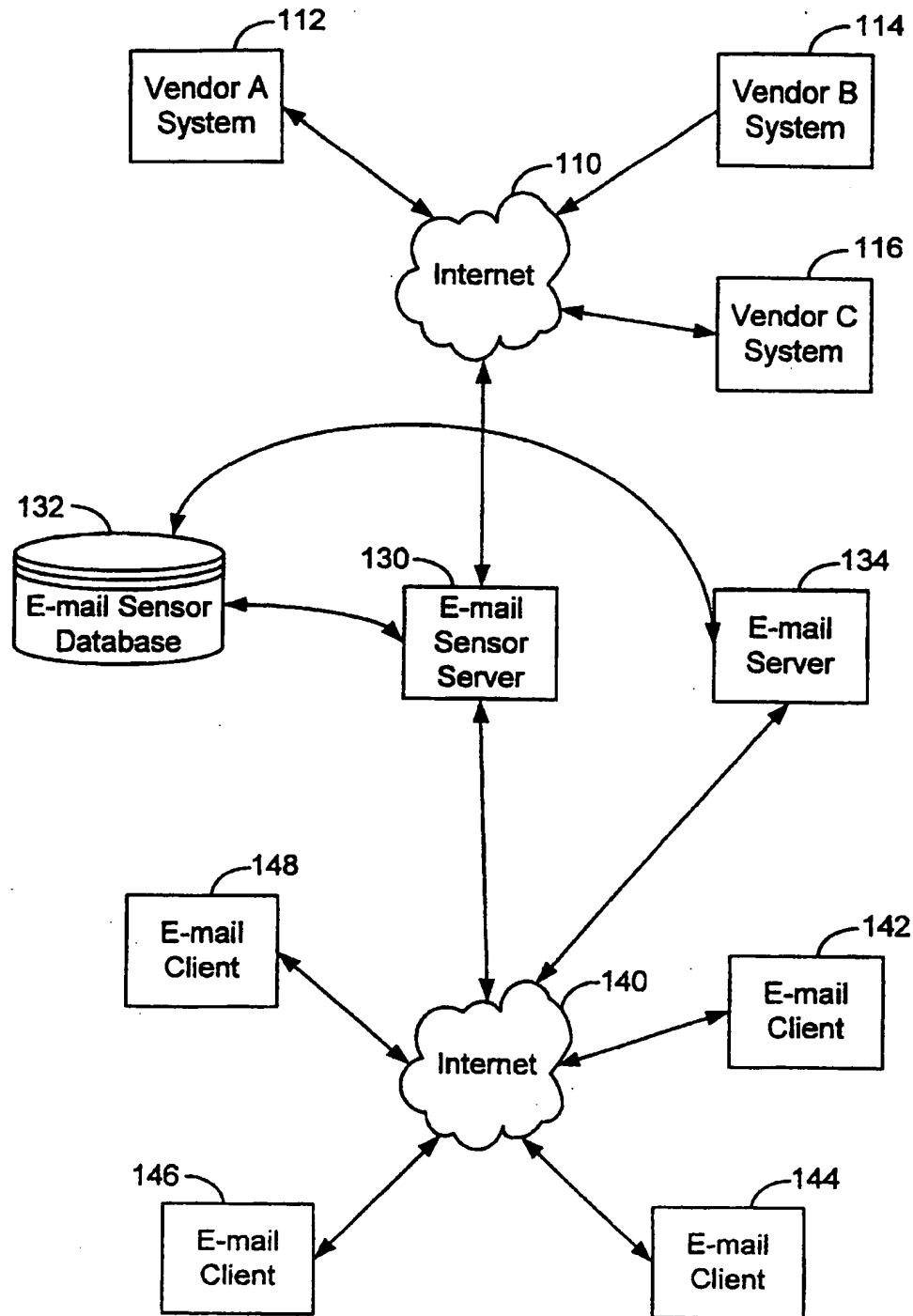
Attachment to the Interview Summary of Paper No. 28.

Mr. Far-hadian and Mr. Eisen began by describing the invention. It is directed to an e-mail that includes a link to a website. The link takes the form of that shown in Fig. 6B, namely <http://www.mystore.com/?XXXXX>. The link includes a "unique identifier" (which is seen as "XXXXX" in the link of Fig. 6B). This unique ID is associated with the e-mail address that the link is mailed to. The unique ID is also logged at the website when the link is "clicked" and is used to identify the user for tracking purposes at the website. This can be seen in element 703 in Fig. 7A where the unique ID shows up in the tracking details for that user.

This differentiates from the Image Tag of Capiel (the applied prior art) which is not "embedding a unique identifier within a website address" which is included "in an electronic mail message sent to the email recipient" (from claim 1). The Image Tag only identifies what type of file formats (HTML, Java, etc.) the e-mail of the user can process and does not have the claimed unique identifier and does not perform the claimed logging actions.

Mr. Far-hadian said that the applicant was considering either a request for reconsideration or possibly appeal at this point as the application has already been through numerous rejections.

If applicants decide to go the request for reconsideration route, the examiner will have to perform the mandatory updated search. Since prosecution has been lengthy, all effort will be made at identifying more pertinent prior art during the next search, which will include a search of relevant analogous network monitoring areas in Class 709, and at discussing this art in an interview environment in an effort to identify patentable limitations that can be drafted into a claim in order to put the case into condition for allowance.

**FIG. 1.**

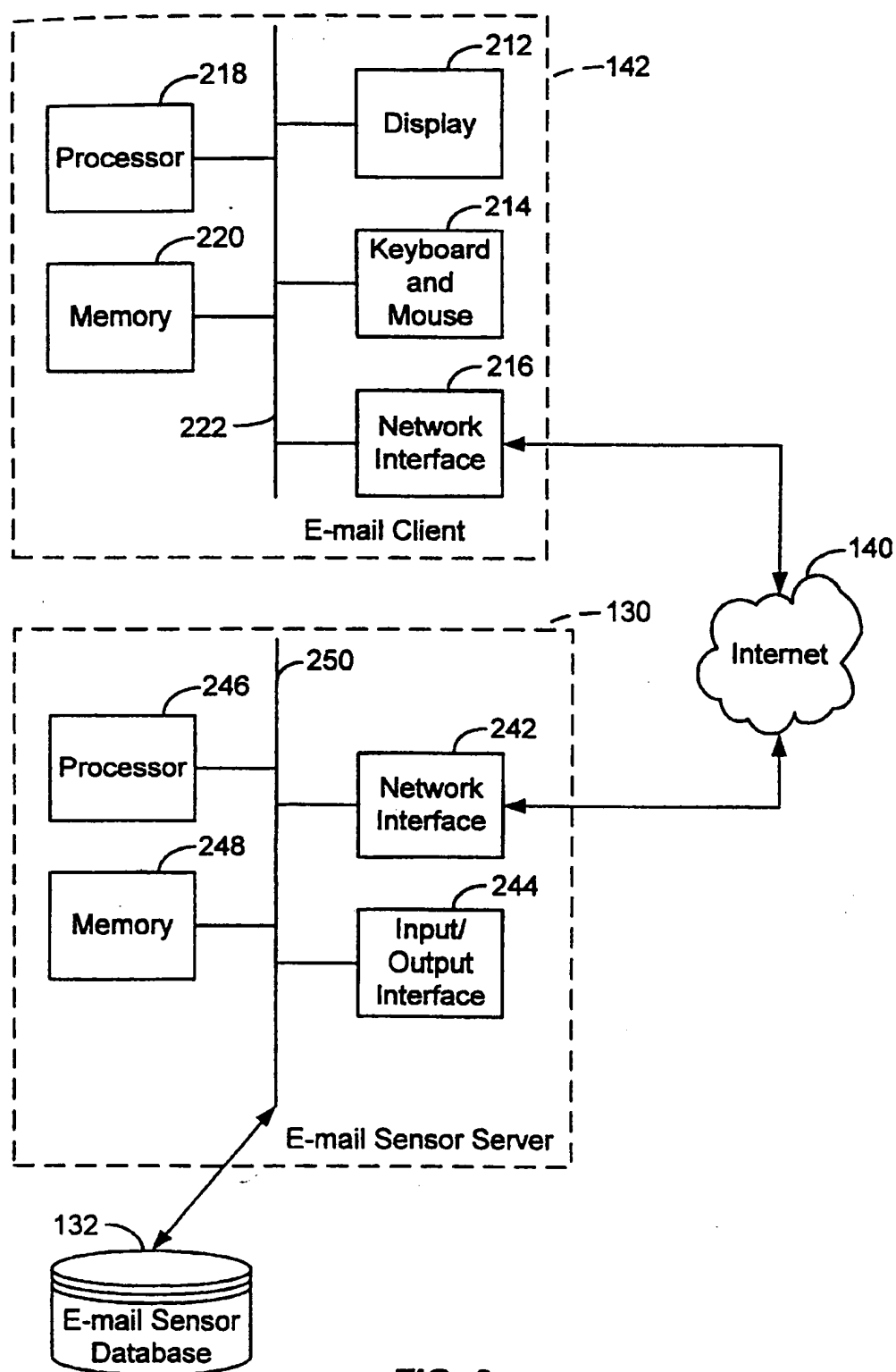
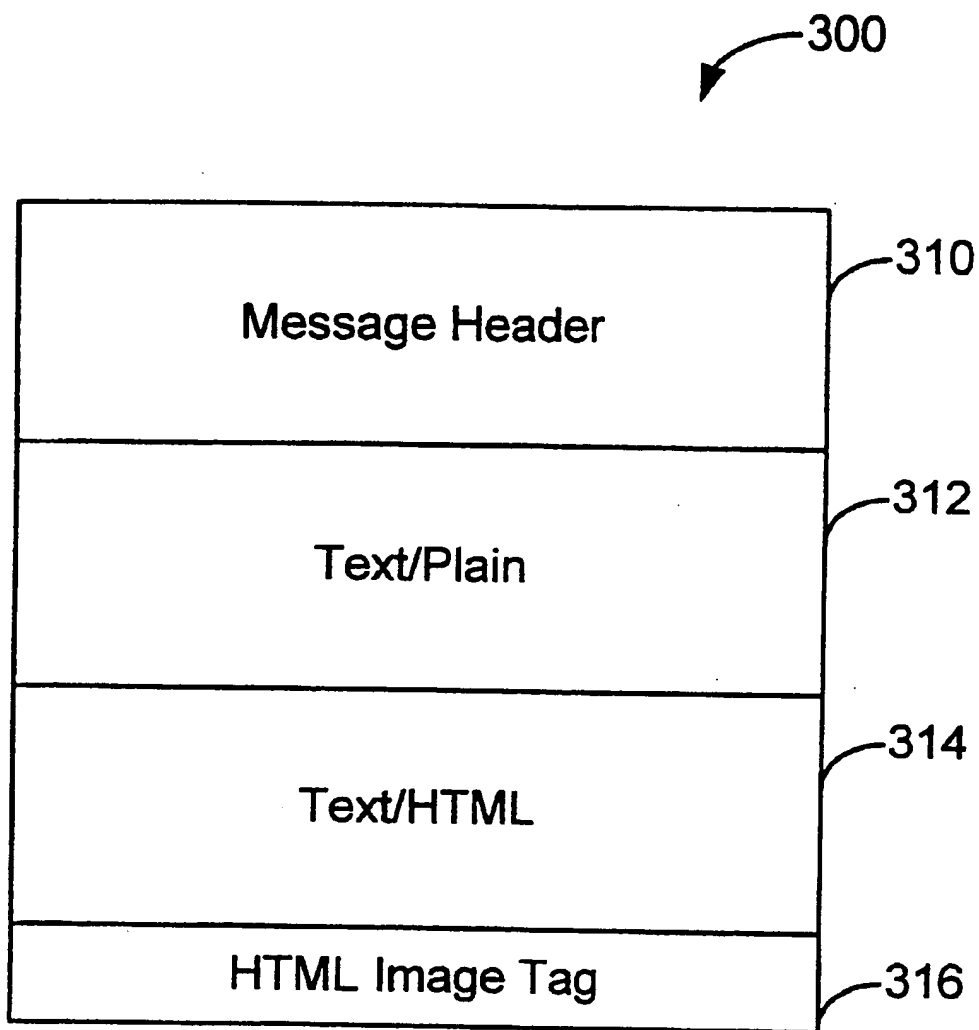


FIG. 2.

**FIG. 3.**